

Response to Office Action
SN 10/612,504
Customer No. 33354

REMARKS

A. Status of the Claims

Claims 1-10, 13-30, 32, and 35-39 are pending. Claims 1-10, 13-30, and 32 are rejected based on prior art. Claims 1, 2, 23, 30, and 32 are currently amended to more clearly recite what Applicants regard as their invention. Claims 35-39 are added by this amendment.

B. New Claims 35-39

Applicants are adding claims 35-39 for the Examiner's consideration. A credit card payment form is included herewith for the \$100 fee associated with the additional independent claim. No extra fee is believed to be owed for the remaining four additional dependent claims because Applicants have previously cancelled at least four claims which were already paid for. See MPEP §607. These new claims are directed at a method of treating a patient with Applicants' device and include a limitation that the two separate laser beams are at different wavelengths. No new matter is added by these claims. See paragraph 0022 and Fig. 7 of the specification as filed.

C. Amendments to the Specification

The Examiner noted in the office action that the full continuation data, including the patent number is required. In response, Applicants have amended the first paragraph to include the patent number.

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D. Double Patenting

The Examiner has rejected claims 1-10, 13, 14, 17, 18, 21 and 23-27 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 and 13 of U.S. Patent 6,746,473. Upon a notice of allowance, and assuming such terminal disclaimer is still required, Applicants will file a terminal disclaimer and an assignment fully complying with 37 CFR § 1.321 and 37 CFR § 3.73.

E. § 102 Rejections Citing Tatebayashi

The Examiner continues to reject claims 1-7, 9, 10, 12 and 23-25 under 35 USC §102(b) as being anticipated by Tatebayashi. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As the Examiner knows, Tatebayashi secures the probes within a probe support table and locks them into place with flexible pipes. Applicants do not use either a support table or flexible pipes to secure the handheld probes. Instead, Applicants' probes are completely handheld and supported by the user's hand during use.

Applicants have amended claims 1 and 23 to recite that the handheld probes are not connected to a support structure while they are being freely moved relative to the patient's skin. Applicants do not consider the power cord attached to each handheld wand to be a "support structure" as the cord provides

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no structural support to the probe. Since Tatebayashi fails to disclose probes that are not connected to a support structure, it does not anticipate newly amended claims 1 and 23 and the Examiner is respectfully requested to withdraw this rejection. The Examiner is also requested to withdraw the rejection of claims 2-7, 9, 10, 24, and 25 based on their dependency to allowable base claims.

F. § 102 Rejections Citing Gerdes

The Examiner continues to reject claims 30 and 32 as being anticipated by U.S. patent 6,267,779 to Gerdes. Again, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc.*, 2USPQ2d at 1053.

Gerdes does not disclose, either expressly or inherently, that the laser sources may be in the wand. Gerdes discloses that the laser sources are housed in a cabinet and that the laser beam is carried to the wand by means of a fiber optic cable. See Fig. 1, which illustrates the fiber optic cables attached to the cabinet and Fig. 4, which illustrates the laser sources attached to the fiber optic cables. See also column 5, line 14, column 8 lines 23-25, and column 9 lines 54-59 which disclose that the laser beams are transmitted to the wands via fiber optic cables, and that the laser sources are in the cabinet.

In contrast, Applicants' preferred embodiment provides that the laser sources are mounted within the wand. Applicants have amended independent

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claim 30 to clarify that the laser source is in the wand. Therefore, Gerdes does not anticipate claim 30 because Gerdes does not disclose one of Applicants' claimed structural elements, namely that the laser sources are in the wand. Claims 30 and 32 have also been amended to more clearly recite what Applicants regard as their invention. Specifically, these claims now include limitations that the probes are hand held and that each laser source emits light at a different wavelength from the other laser source. No new matter is added by these claim amendments. See paragraph 0022 and Fig. 7 of the specification as filed.

Applicants respectfully request that this rejection of independent claim 30 be withdrawn. Additionally, the Examiner is requested to withdraw this rejection as it applies to dependent claim 32 due to its dependency on an allowable base claim.

F. § 103 Rejections Citing Tatebayashi in View of Gerdes

The Examiner has rejected claims 8, 13-22 and 26-29 as being obvious in light of Tatebayashi in view of Gerdes. A claim is *prima facie* obvious only if the prior art reference (or references when combined) teach or suggest all the claim limitations. *MPEP* §2143.

Dependent claims 8 and 13-22 all depend from claim 1 while dependent claims 26-29 all depend from claim 23 and therefore include all the limitations of these base claims. These base claims have been amended to recite specific

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limitations not found in Tatebayashi relating to handheld probes that are not connected to any support structures. In addition to failing to disclose these elements, Tatebayashi teaches against the amended claims by requiring that the probes be locked into place. Since Tatebayashi fails to disclose claimed limitations and teaches away from the claimed invention, the Examiner is respectfully requested to withdraw these rejections as well.

CONCLUSION

Applicants respectfully submit that all objections and rejections have been traversed, and that the application is in form for issuance. If the Examiner has any suggestions or comments that would place the application in even better form for allowance, he is invited to call Applicants' representative, Damon Ashcraft at 602-681-3331.

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Dated

Respectfully submitted,

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